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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,266	03/20/2000	L. K. Dunican	PM 258100	5657

909 7590 03/11/2003  
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EXAMINER

STEADMAN, DAVID J

ART UNIT PAPER NUMBER

1652

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/531,266

Applicant(s)

DUNICAN ET AL.

Examiner

David J. Steadman

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-30,32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19,22,27-30,32 and 33 is/are rejected.
- 7) ☒ Claim(s) 20,21 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: sequence comparison.

Art Unit: 1652

## **DETAILED ACTION**

### ***Status of the Application***

Due to a new rejection not raised in a previous Office action, the finality of the rejection of the last Office action is withdrawn.

Claims 17-30 and 32-33 are pending in the application.

Applicants' cancellation of claim 31 and amendment to claims 17, 18, 24-26 in Paper No. 17, filed 10/28/02, is acknowledged.

Applicants' arguments filed in Paper No. 17 have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

The text of those sections of Title 35 U.S. Code not included in the instant action can be found in a prior Office action.

### ***Claim Objections***

1. Claims 17, 18, 20-23, are objected to as being grammatically incorrect as follows:
  - a. Claims 17 and 18 recite "nucleotide sequences encoding a protein" and should be replaced with, for example, "a nucleotide sequence encoding a protein";
  - b. Claims 22 and 23 use a ";" where a "," should be used; and
  - c. Claims 27 and 30 recite "the DNA" and should be placed with, for example, "the isolated DNA" in order to maintain consistency.
2. Applicant is advised that should claim 20 be found allowable, claim 21 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. In this case, nucleotides 2471-3550 of SEQ ID NO:1 and nucleotides 1-1080 of SEQ ID NO:3 are identical and encode the same protein (see item below). Thus, the claims are duplicate claims. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper

Art Unit: 1652

after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejection(s) – 35 USC 112, Second Paragraph***


3. Claims 17, 18, and 24-26 (claims 19-21, 27-30, 32, and 33 dependent therefrom) are rejected as the amino acid sequences of SEQ ID NO:2 and SEQ ID NO:4 are identical (see attached sequence comparison). It is suggested that applicants remove either "SEQ ID NO:2" or "SEQ ID NO:4" from the claims.
4. Claims 19 and 22 (claims 27-30, 32, and 33 dependent therefrom), are rejected to as the nucleotide sequences of nucleotides 2471-3550 of SEQ ID NO:1 and nucleotides 1-1080 of SEQ ID NO:3 are identical. It is suggested that applicants amend the claims to remove either "SEQ ID NO:1 nucleotides 2471 to 3550" or "SEQ ID NO:3 nucleotides 1 to 1080".

***Conclusion***

5. Claims 17-19, 22, 27-30, 32, and 33 are rejected.
6. Claims 20, 21, and 23 are objected to for the reasons described above.
7. No claim is in condition for allowance.
8. The claims would be allowable if rewritten to overcome the objections and rejections set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for Group 1600 is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.  
Patent Examiner  
Art Unit 1652

  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
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